

**Application No.:** 10/748,745  
**Filing Date:** December 30, 2003

## REMARKS

Claims 1-13 and 50-78 were previously pending. In response to an oral restriction requirement, Applicant had orally elected Group I, including Claims 1-13 and 50-62 without traverse. Applicant confirms the election of Group I without traverse. Claims 63-78 have been cancelled. Therefore, Claims 1-13 and 50-62 remain pending.

Claims 1, 3, 6, 9-10, 12-13, 50, 52, 55, 58-59, and 61-62 stand rejected under 35 USC 102(b) as being anticipated by U.S. Patent Publication No. 2002/0077929 to Knorr. Claims 2 and 51 stand rejected under 35 USC 103(a) over Knorr in view of U.S. Patent Publication No. 2004/0260710 to Marston et al. Claims 4 and 53 stand rejected under 35 USC 103(a) over Knorr in view of U.S. Patent Publication No. 2003/0097311 to Shinohara et al. Claims 5, 8, 11, 54, and 57 stand rejected under 35 USC 103(a) over Knorr in view of Official Notice. Claims 7 and 56 stand rejected under 35 USC 103(a) over Knorr in view of U.S. Patent Publication No. 2003/0130903 to Silverbrook et. al.

### Claims 1, 3, 6, 9-10, 12-13, 50, 52, 55, 58-59, and 61-62 Are Not Anticipated by Knorr

For the reasons set forth below, Applicant respectfully submits that the rejection of Claims 1, 3, 6, 9-10, 12-13, 50, 52, 55, 58-59, and 61-62, under 35 U.S.C. § 102(a) is improper and therefore traverses the rejection of Claims 1, 3, 6, 9-10, 12-13, 50, 52, 55, 58-59, and 61-62.

A prior art reference does not anticipate the pending claims if it does not, alone, identically disclose each element of the Applicant's claims. MPEP § 2131; *See also, In re Attwood*, 148 USPQ 203, 210-211 (CCPA 1966). Even if the prior art disclosure is "substantially the same" as the claimed invention, anticipation may not be found. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 1560, 225 USPQ 253, 256 (Fed. Cir. 1985). Only when a prior art reference claim either expressly or inherently describes each and every element as set forth in the claim should the claims be rejected as being anticipated. *Verdegaal Bros., Inc. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d. 1051, 1053 (Fed. Cir. 1987); *See generally, In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1982).

Because Knorr does not disclose, expressly or inherently, each claim element of Claims 1, 3, 6, 9-10, 12-13, 50, 52, 55, 58-59, and 61-62, Applicant submits that the rejection of these claims is improper.

Claims 1 and 50

In rejecting Claims 1 and 50, the Office Action alleges that Knorr, at paragraph 65, discloses “a second module that, based at least in part on information retrieved from the database, identifies at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order”. However, a careful reading of the citation relied upon by the Office Action fails to disclose the foregoing elements or even a mention of identifying at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order.

The Office Action further alleges that paragraph 65 of Knorr discloses a third module that causes a notification to be presented to the user, wherein the notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment. In making this assertion, the Office Action states that the Office Action is interpreting interacting with the customer as notifications. Again, a careful reading of the citation relied upon by the Office Action fails to disclose the foregoing elements.

For convenience, paragraph 65 of Knorr is reproduced below.

*[0065] FIG. 9B shows the next portion of the timeline, long term monitoring mode 606, including purchaser path 502, electronic vendor path 506, with the database path being bifurcated at 529 into an order pending database path for purchasers 504A and an order pending database path for electronic vendors 504B. In the purchaser path at 540, the purchaser may optionally input instructions about shipping, consolidating item requests, special handling, or other changes at any time during the monitoring mode. The order pending shopping cart may also be cancelled or modified anytime during the monitoring mode. As indicated in the order pending database path at 542, the order pending database holds the information for the order pending shopping cart for that event. The data in the order pending database is fluid or variable at this point and may be changed by the purchaser. As indicated in the order pending database path for electronic vendor at 544, selection in the order pending shopping cart can be processed and updated in batch mode, for example, at night, for access by the electronic vendor(s) who had transactions complete during the prior day. As indicated in the electronic vendor path at 546, the vendor can use the time between the electronic hold and the ultimate order execution to plan inventory and interact with the purchaser for suggestive sellings, i.e., up-selling and or cross-selling. Other suggestive selling opportunities may be afforded in conjunction with the logistics assurance modality discussed earlier. For example, in the event of product unavailability, an alternate or suitable substitute product may be presented to the purchaser, or in suitable cases, the recipient. For example, this opportunity may arise with regard to new model replacement of an outdated model of an item.*

**Application No.:** 10/748,745  
**Filing Date:** December 30, 2003

The only mention of shipping in the above citation is the following “In the purchaser path at 540, the purchaser may optionally input instructions about shipping, consolidating item requests, special handling, or other changes at any time during the monitoring mode”. Thus, while the above citation states that a user can input shipping instructions, no mention is made of identifying an article that can be added to a pending order within a first amount of time without delaying the shipment date of the pending order. Because Knorr fails to expressly or inherently disclose identifying an article that can be added to a pending order without delaying the shipment date of the pending order, Knorr further fails to expressly or inherently disclose providing a notification that indicates that the user can add at least the first article to the pending order without delaying the pending order shipment.

Therefore, because Knorr fails to inherently or explicitly disclose at least one element of Claim 1 and of Claim 50, Knorr cannot anticipate Claims 1 and 50.

Claims 3 and 52

In rejecting Claims 3 and 52 as being anticipated by Knorr, the Office Action argues that Knorr, at paragraph 42, discloses “wherein the third module causes the notification to be presented to the user at least partly in response to determining that the user is accessing the computer network.” However, because Knorr does not disclose providing the notification of Claim 1 (wherein the notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment) or Claim 50, Knorr does not expressly or inherently disclose providing the notification as claimed. Therefore, because Knorr fails to inherently or explicitly disclose at least one element of Claim 3 and of Claim 52, Knorr cannot anticipate Claims 3 and 52.

Claims 6 and 55

In rejecting Claims 6 and 55 as being anticipated by Knorr, the Office Action argues that Knorr, at paragraph 42, discloses wherein the notification includes an order incentive. However, while Knorr discloses providing inducements, Knorr does not disclose providing an inducement in a notification indicating that the user can add at least a first article to the pending order without delaying the pending order shipment.

For convenience, paragraph 42 of Knorr is reproduced below.

*[0042] In some methods, the event profile data elements are obtained directly from the recipient or the purchaser, for example, by keying into the order pending application. In some situations, a third-party database, such as a PDA database or electronic address book can be the electronic source of the event information. A recipient profiling step 36 may be executed to obtain information about the intended item recipient. The recipient profile information can include name, address(es), phone, age, gender, gift preferences, and/or catalogs of special dates associated with that particular recipient, or other information. In a business-to-business environment, the recipient identifier information can include company name, contact name, SIC code, product/service categories or other information. The recipient profiling data points obtained in step 36 may be obtained directly from the recipient or the purchaser by keying into the order pending application. In some situations, a third-party database such as a PDA database or electronic address book can be the electronic source of the event information. In conjunction with the interface to a third-party database, e.g., a PDA or PC calendar or scheduler such as Microsoft® Outlook®, information from the order pending database may execute certain events within the third-party scheduler. For example, a purchaser or potential purchaser may be presented with an array of events entered in their scheduler for which they may wish to pend an order with the order pending database. Based on this body of events, periodic reminders of events for which no order is pended may be presented to the purchaser to suggest pending an order, or even suggesting suitable items pertinent to widely-recognized events such as holidays, perhaps with regard to certain individuals from the purchaser's personal individual contacts database. Alternatively, existing pending orders may be shown, e.g., with an icon or thumbnail picture of a selected item, in conjunction with upcoming events in the personal scheduler of the purchaser. This may be linked to suggestive selling or upgrading solicitations or inducements, e.g., special offers or coupons.*

Indeed, the above citation fails to even mention shipping timing.

Therefore, because Knorr fails to inherently or explicitly disclose at least one element of Claim 6 and of Claim 55, Knorr cannot anticipate Claims 6 and 55.

#### Claims 9 and 58

In rejecting Claims 9 and 58 as being anticipated by Knorr, the Office Action argues that Knorr, at paragraph 65, discloses wherein the first article is identified based in part on at least one article type in the pending order. The Office Action interprets cross selling as being based on an article type of a pending order. Applicant respectfully traverses the Office Action's characterization. Cross selling does not inherently include identifying an article based in part on at least one article type in the pending order. Cross-selling is a broad term, with different potential meanings. For example, Webster's New Millennium™ Dictionary defines "cross-sell" as follows: "to suggest that customers buy additional, complementary, or related accessories or products during or just after their primary purchase." Webster's New Millennium™ Dictionary of

**Application No.:** 10/748,745  
**Filing Date:** December 30, 2003

English, Preview Edition (v 0.9.7). Lexico Publishing Group, LLC. 18 Nov. 2008. Thus, because cross selling may merely refer to suggesting that customers buy additional products, Knorr does not inherently or expressly disclose wherein the first article is identified based in part on at least one article type in the pending order. Therefore, because Knorr fails to inherently or explicitly disclose at least one element of Claim 9 and of Claim 58, Knorr cannot anticipate Claims 9 and 58.

Claims 10 and 59

In rejecting Claims 10 and 59 as being anticipated by Knorr, the Office Action argues that Knorr, at paragraph 65, discloses that the first article is identified based in part on user history order information retrieved from the database. However, a careful reading of the citation relied upon by the Office Action fails to disclose the foregoing elements. While Knorr refers to a pending order database and to suggestive selling, the citation relied upon by the Office Action does not expressly or inherently disclose that the suggestive selling of Knorr involves identifying an article that can be added to the pending order based in part on user history order information retrieved from a database, much less the invention as claimed. Therefore, because Knorr fails to inherently or explicitly disclose at least one element of Claim 10 and of Claim 59, Knorr cannot anticipate Claims 10 and 59.

Claims 12 and 61

In rejecting Claims 12 and 61 as being anticipated by Knorr, the Office Action argues that Knorr, at paragraphs 42 and 65, discloses that the first article is identified based in part on user preference information retrieved from the database. However, a careful reading of the citation relied upon by the Office Action fails to disclose the foregoing elements. While paragraph 65 of Knorr mentions suggestive selling, including cross selling, and paragraph 42 mentions a recipient profile (as opposed to a purchaser profile), the citations relied upon by the Office Action do not expressly or inherently disclose that the suggestive selling of Knorr involves identifying an article that can be added to the pending order based in part on preference information of a user placing an order, wherein the preference information is retrieved from a database. Therefore, because Knorr fails to inherently or explicitly disclose at least one element of Claim 12 and of Claim 61, Knorr cannot anticipate Claims 12 and 61.

Claims 13 and 62

In rejecting Claims 13 and 62 as being anticipated by Knorr, the Office Action argues that Knorr, at paragraphs 42 and 65, discloses wherein the notification is provided to the user after the pending order was placed. However, a careful reading of the citation relied upon by the Office Action fails to disclose the foregoing elements. Indeed, because Knorr fails to even provide a notification that indicates that the user can add at least the first article to the pending order without delaying the pending order shipment, as discussed with respect to Claim 1, Knorr further fails to expressly or inherently disclose providing such notification to the user after the user's pending order is placed. Therefore, because Knorr fails to inherently or explicitly disclose at least one element of Claim 13 and of Claim 62, Knorr cannot anticipate Claims 13 and 62.

Discussion of the Rejections under 35 USC 103(a)

As set forth below, Applicant has traversed the rejections of the pending claims under Section 103(a). The cited art relied on in the Office Action does not disclose or suggest all of the elements of the pending claims. Nor does the Office Action adequately explain why the differences between the pending claims and the cited art would have been obvious to one of ordinary skill in the art. "With regard to rejections under 35 U.S.C. § 103, the Examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a prima facie case of obviousness) is more probable than not." MPEP §2142. Accordingly, "the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." MPEP §2142; *see KSR International Co. v. Teleflex, Inc.*, 550 U.S. \_\_\_, (2007)).

Even once a prima facie case of obviousness is established, it can be rebutted in situations in which the art taught away from the claimed combination. See, *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997)).

Claims 2 and 21

In rejecting Claims 2 and 21, the Office Action admits that Knorr fails to disclose wherein the notification is an icon displayed via a toolbar on a user terminal. Nonetheless, the Office Action relies on Marston to supply the missing elements, stating that it would have been obvious to modify the system of Knorr to include the teachings of Marston to alert a user of a

**Application No.:** 10/748,745  
**Filing Date:** December 30, 2003

change in the system. However, because neither reference discloses providing any type of notification that indicates that a user can add at least the first article to a pending order without delaying the pending order shipment, even if Knorr were modified with the icon of Marston, the result would still fail to provide such a notification as an icon displayed via a toolbar on a user terminal. Thus, for this reason as well, Applicant respectfully submits that the rejection of Claims 2 and 21 is improper.

Claims 4 and 53

In rejecting Claims 4 and 53, the Office Action admits that Knorr fails to disclose wherein the notification is provided via an email transmitted to a user email address. Nonetheless, the Office Action relies on Shinohara to supply the missing elements, stating that it would have been obvious to modify the system of Knorr to include the teachings of Shinohara to receive the status of an ordered item. However, the notification referred to in the claim is not providing the status of an ordered item. Instead, notification indicates that a user can add at least the first article to a pending order without delaying the pending order shipment. Thus, for at least this reason, the Office Action has failed to make a prima facie case of obviousness.

In addition, because neither Knorr nor Shinohara disclose providing any type of notification that indicates that a user can add at least the first article to a pending order without delaying the pending order shipment, even if Knorr were modified with the email of Shinohara, the result would still fail to provide such an email notification that indicates that a user can add at least the first article to a pending order without delaying the pending order shipment. Thus, for this reason as well, Applicant respectfully submits that the rejection of Claims 4 and 53 is improper.

Claims 5 and 54

In rejecting Claims 5 and 54, the Office Action admits that Knorr fails to disclose wherein the notification includes a link, wherein if the user activates the link after the first amount of time, the user is provided a message indicating that the first amount time to add articles to the pending order has expired. Nonetheless, the Office Action takes Official Notice that a notification including a link and providing a notification to a user that a link has expired is old and well known. Applicant traverses the Office Action's finding that a notification including a link and providing a notification to a user that a link has expired is old and well known. If the

**Application No.:** 10/748,745  
**Filing Date:** December 30, 2003

Office Action maintains the rejection over Office Notice, Applicant requests that the Office Action provide documentary evidence to support the finding.

Further, even assuming, for the sake of argument, that a notification including a link and providing a notification to a user that a link has expired is old and well known, and even if the system of Knorr were modified to include the teachings of the Office Action's alleged Office Notice, the result would still not provide a message indicating that the first amount time to add articles to the pending order has expired, as neither Knorr nor the Office notice disclose a message indicating that the first amount time to add articles to the pending order has expired. Thus, for this reason as well, Applicant respectfully submits that the rejection of Claims 5 and 54 is improper.

Claims 8 and 57

In rejecting Claims 8 and 57, the Office Action admits that Knorr fails to disclose wherein the location information is used by the second module to determine how long it would take to transport the first article from a storage area to a packing area. Nonetheless, the Office Action takes Official Notice that using location information to determine transport time to an area is old and well known and asserts that it would be obvious to modify the system of Knorr to include the teachings of Official Notice to calculate an estimated shipment date. However, even if the system of Knorr were modified to include the teachings of the Office Action's alleged Office Notice, the result would still not use the location information to identify at least a first article that can be added to a pending order within a first amount of time without delaying the shipment date of the pending order. Thus, for this reason as well, Applicant respectfully submits that the rejection of Claims 8 and 57 is improper.

Claims 11 and 60

In rejecting Claims 11 and 60, the Office Action admits that Knorr fails to disclose wherein the first article is identified based in part on the quantity of the first article in inventory in an order fulfillment center from which at least one article in the pending order is to be shipped. Nonetheless, the Office Action takes Official Notice that identifying an article based on a quantity available in a shipping center is old and well known and asserts that it would be obvious to modify the system of Knorr to include the teachings of Official Notice to up-sell overstocked items. Applicant notes that neither Knorr nor Official notice are concerned with or even mention

**Application No.:** 10/748,745  
**Filing Date:** December 30, 2003

up-selling overstocked items, and so there would be no motivation to modify the system of Knorr as proposed by the Office Action. Further, even if the system of Knorr were modified to include the teachings of the Office Action's Office Notice, the result would still not use the quantity information to identify at least a first article that can be added to a pending order within a first amount of time without delaying the shipment date of the pending order. Thus, for this reason as well, Applicant respectfully submits that the rejection of Claims 11 and 60 is improper.

Claims 7 and 56

In rejecting Claims 7 and 56, the Office Action admits that Knorr fails to disclose a fourth module, that, during a second network session, provides that user with an interface via which the user can add the at least first article to the pending order. Nonetheless, relies upon Silverbrook to supply the missing elements. Applicant respectfully maintains that the Office Action has inadvertently mischaracterized Silverbrook. While Silverbrook discloses adding an item to a pending order, it appears that the item is added during the same session as the pending order, rather than during a second network session. Further, even if the system of Knorr were modified to include the teachings of Silverbrook, the result would still not enable a user to add an article that had been identified to the user as being addable to a pending order within a first amount of time without delaying the shipment date of the pending order. Thus, for this reason as well, Applicant respectfully submits that the rejection of Claims 7 and 56 is improper.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

**Application No.:** 10/748,745  
**Filing Date:** December 30, 2003

Conclusion


In view of the foregoing, Applicant respectfully submit that Claims 1-13 and 50-62 are patentably distinct over the cited art and are in condition for allowance. Applicant therefore respectfully requests allowance of Claims 1-13 and 50-62.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: December 17, 2008

By:   
\_\_\_\_\_  
David N. Weiss  
Registration No. 41,371  
Attorney of Record  
Customer No. 20995  
(310) 551-3450

6261430  
111908